

REMARKS

In this Amendment, Applicant has amended Claims 1 to correct a clerical error and rearrange some expressions. The amendment of Claim 1 is editorial in nature. It is respectfully submitted that no new matter has been introduced by the amended claim. All claims are now present for examination and favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

REJECTIONS UNDER 35 U.S.C. § 102 (e):

Claim 1 has been rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by Risafi et al. (US 6,473,500), hereinafter Risafi.

Applicant traverses the rejection and respectfully submits that the present-claimed invention is not anticipated by the cited reference.

It is respectfully submitted that to satisfy the requirements of § 102, *each and every* element of a claimed invention must be found in the cited anticipative reference; it is insufficient that the corresponding element in the cited anticipative reference be “equivalent” to the element of the claimed invention. *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). It is further respectfully submitted that in order to anticipate the presently claimed invention, a reference must contain all of the essential elements in the invention as claimed. *Lewmar Marine Inc. v. Barient Inc.*, 827 F.2d 744, 3 USPQ 1766 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Further, a reference that merely contains substantially the same elements is insufficient to “anticipate” the claimed invention. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985).

Claim 1 of the present invention is directed to a system which conducts settlement of payments for both a telephone service on the telephone network and an electronic

commercial transaction service on the data communication network using the pre-paid card after the initial account setup has already been carried out, which mean, the user has been in a state in which he or she could use the pre-paid card. Risafi, however, discloses an electronic system comprising a pre-paid card in the form of smart card or a magnetic stripe card. The Examiner cites Figure 5a as disclosing an initial account setup with PIN assignment and balance (col. 12, lines 26-51) and Figures 9a – 9d as disclosing purchase, use and reloading of the pre-paid smart card. However, the methods for purchasing the pre-paid card, setting it up, allocating PIN and reloading the pre-paid card depart from the scope of Claim 1 of the present invention. Therefore, the cited parts from Rifasi do not anticipate Claim 1 as they are not the elements required by Claim 1 of the present invention.

More importantly, the present invention requires the integral settlement of payments for both the telephone service on the telephone network and the electronic commercial transaction service on the data communication network using the pre-paid card. This important element is NOT disclosed in any way in the Risafi. On the contrary, Risafi only teaches independent and separate settlement of payments for both services mentioned above.

More specifically, Claim 1 of the present invention requires a pre-paid calling card system through which “respective payments requested to be settled through the telephone net work and the data communication network being integrally balanced from balance information ... in the master database.” (amended Claim 1, page 2, lines 13-15) In addition, Claim 1 of the present invention requires “payments of various goods and services respectively requested through the telephone network and the data communication network being integrally carries out with one said pre-paid card.” (amended Claim 1, page 5, from bottom lines 3-5)

On the contrary, Risafi indicates that a user should purchase separate pre-paid cards used for the phone service and the electronic commercial transaction service. For

example, Figure 4 illustrates the purchase of a pre-paid card for electronic commercial transaction service, in which the card and account files are placed in a PDC (col. 11, line 43 through col. 12, line 9). Distinctively, Risafi uses different flowchart – Figure 9 -- to illustrate the purchase of a “telephone card” (col. 16, line 12), in which, besides the steps of establishing the card and account files at a PDC, the PDC has to access to a TELCO and “TELCO adds the card number to its card file.” (col. 16, lines 13-33) Accordingly, when a card purchaser initially approaches a selling agent, the selling agent must make inquiries to the card purchaser whether he or she wants a card for purchasing goods or a telephone card. Otherwise, according to the disclosure in Risafi, if the selling agent presumes the card purchaser wants a card for purchasing goods or withdrawing cash, the card and account files will only be placed with the PDC. Thus, when the card user intends to use the card to purchase telephone service, the card will not be functioning, because there are no card and account files in the TELCO database. Accordingly, a separate telephone card has to be purchased. Therefore, the pre-paid cards as disclosed in Risafi have to be used separately, which means in separate cards. The user cannot simultaneously use the telephone service and the electronic commercial transaction service by means of one pre-paid card. The present invention, however, enables the integral settlement of payments for both the telephone service and the electronic commercial transaction service. The user can simultaneously use the telephone service and the electronic commercial transaction service by means of one pre-paid card.

Therefore, Risafi does not disclose the requirement for the “integral” processing both above-identified services by means of one pre-paid card as claimed in the present invention.

In addition, the system configuration and database structure in the present invention enables the use of one pre-paid card for both above-identified services. The present invention requires a master database controlled by the pre-paid calling card system. For example, the present invention utilizes the present PCCS (prepaid calling card system) database of the TELCO as an integral account database of the whole system.

Thus, the present invention does not require any intermediate account database as disclosed in Risafi (e.g. PDC), minimizes the number of database and saves costs. However, Risafi independently builds and operates two databases separately -- a database adapted for settling a payment for the telephone service at a TELCO side and a database adapted for settling a payment for the purchasing goods, service and withdrawing cash etc. at a PDC side.

Accordingly, Risafi does not contain each and every element of Applicant's invention presently claimed. It is respectfully submitted that Risafi does not anticipate the claimed invention. In view of the foregoing, withdraw of the rejection under 35 U.S.C. § 102 (e) is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103:

Claims 2 – 4 have been rejected under 35 U.S.C. § 103, as allegedly being obvious and unpatentable over Risafi in view of Gottfreid (US6,076,076).

Applicant traverses the rejection. In addition to the differences between Risafi and the present invention as stated above, neither Risafi nor Gottfreid have suggestion or incentive to combine these two references together to achieve the present invention. Even combined, Risafi and Gottfreid do not teach or suggest the present invention as in the Claims 2-4. The Examiner recognizes that "Risafi fails to explicitly teach or fairly suggest of selling the pre-paid card over the Internet." Gottfreid only mentions that "the purchase of the cards... by on-line mechanisms" and fails to disclose anything concrete as to how to organize an electronic payment system to make it possible. Therefore, one of ordinary skilled in the art would not discern the present invention in Claims 2-4 at the time of its invention, which directs to a system that conducts settlement of payment for both a telephone service on the telephone network and an electronic commercial transaction service on the Internet integrally using one prepaid card for sending gift, recharge, etc..

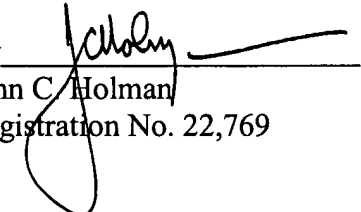
Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §103 be withdrawn.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

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